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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,729	11/26/2003	Dhrubajyoti Borthakur	5760-16000	9799

7590   05/19/2006

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EXAMINER
LE, UYEN T

ART UNIT	PAPER NUMBER
2163	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	10/723,729	BORTHAKUR ET AL.
	Examiner	**Art Unit**	
	Uyen T. Le	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *26 November 2003* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *26 Jan 2005*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Specification

1.   The abstract of the disclosure is objected to because it repeats the language of

the title. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 15-21 are rejected under 35 U.S.C. 101 because the claimed computer-

accessible medium in light of the specification at paragraph 0027 includes transmission

media or signals which are considered non-statutory under the present interim

guidelines for subject matter eligibility posted on USPTO web site on 26 October 2005.

The examiner suggests that applicant amend the claims to recite tangible storage

systems in the claim language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, 18, 19, 21 are rejected under 35

U.S.C. 102(b) as being anticipated by Gruse et al (US 6,389,538) provided by the

applicant.

Regarding claim 8, Gruse discloses all the claimed subject matter (see the abstract, column 6, lines 8-31, column 10, lines 4-50). The claimed plurality of files reads on digital content stored in the method of Gruse (see the abstract, column 9, lines 34-39). The claimed "detecting an operation to access content of a first stored file" is met when the method detects a requested use of the content (see column 10, lines 43-50). The claimed "subsequent to detecting...signature corresponding to said first stored file" is met by the fact that information is logged whenever content is played or copied (see column 6, lines 8-31) and by the digital code kept as part of the usage conditions associated with the content (see column 10, lines 34-50).

Regarding claim 9, Gruse discloses "said operation corresponds to a file read" when Gruse shows that content is played on user devices (see the abstract).

Regarding claim 11, Gruse discloses "said record is stored in a named stream corresponding to said first stored file" when Gruse shows the digital code kept as part of the usage conditions associated with the content (see column 10, lines 34-50) and "wherein the method further comprises storing an indication of said operation in a history stream in response to storing said record in said named stream" when Gruse shows the logging operation (see column 6, lines 8-30).

Regarding claim 12, Gruse discloses "said record is stored in a database configured to store a plurality of entries" when Gruse shows logging every time a content is played (see column 6, lines 8-30) and "said database is further configured to respond to a query of said plurality of entries" when Gruse shows verification of usage conditions (see column 10, lines 47-50). In order to perform verification, the database

storing the logs has to be configured to respond as claimed since the logs keep track of the number of times content has been played.

Claim 14 is met when Gruse shows copying content by the user devices (see the abstract). The record of the copying operation is clearly associated with the second stored file since the second stored file is merely a copy of the first stored file.

Claims 1, 2, 4, 5, 7 and 15, 16, 18, 19, 21 correspond respectively to a system and computer-accessible medium for the method of claims 8, 9, 11, 12, 14, thus are rejected for the same reasons stated in claims 8, 9, 11, 12, 14 discussed above.

4.   Claims 1, 2, 4, 5, 8, 9, 11, 12, 15, 16, 18, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Oren et al (US 6,240,401).

Regarding claim 8, Oren discloses a method including "storing a plurality of files" (see Figure 1, database 25), "detecting an operation to access content of a first stored file" (see Figure 2, steps 50, 52), "subsequent to detecting...signature corresponding to said first stored file" (see Figure 2, steps 54-60). The claimed first stored file reads on the content requested by the user. The claimed record reads on the ticket for content. The claimed record includes a signature corresponding to said first stored file reads on the digital ticket created for content requested by the user and authorized by the user.

Regarding claim 9, Oren discloses said operation corresponds to a file read operation when Oren shows that the user is requesting a movie (see the abstract).

Regarding claim 11, Oren discloses "said record is stored...said name stream" (see Figure 2, steps 60-68).

Regarding claim 12, Oren discloses "wherein said record...plurality of entries"

when Oren shows step 52 in Figure 2. For the method of Oren to decide which branch

of the flowchart to follow, clearly the database has to be further configured to respond to

a query of said plurality of entries as claimed.

Claims 1, 2, 4, 5 and 15, 16, 18, 19 correspond respectively to a system and

computer-accessible medium for the method of claims 8, 9, 11, 12, thus are rejected for

the same reasons stated in claims 8, 9, 11, 12 discussed above.

Claim Rejections - 35 USC § 103

5.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 3, 10, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gruse et al (US 6,389,538) provided by the applicant, further in view of Arai et al (US

2001/0025311).

Regarding claim 10, Gruse discloses said operation is generated by an

application (see item 195). Although Gruse does not specifically show said record

includes an identity of said application, it is well known in the art to do so to identify the

access request source as shown by Arai (see 0015). Therefore, it would have been

obvious to one of ordinary skill in the art to include an identity of said application in said

record while implementing the method of Gruse in order to identify the application as the

access request source as taught by Arai.

Claims 3 and 17 correspond respectively to a system and computer-accessible

medium for the method of claim 10, thus are rejected for the same reasons stated in

claim 10 discussed above.

7.   Claims 6, 13, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gruse et al (US 6,389,538) provided by the applicant, further in view of Alumbaugh et al

(US 2003/0172368).

Regarding claim 13, although Gruse does not specifically show said record is

stored in XML format, it is well known in the art to do so as shown by Alumbaugh (see

0028). Therefore, it would have been obvious to one of ordinary skill in the art to include

storing the record in XML format while implementing the method of Gruse in order to

use a standardized format that facilitates interchange of data between heterogeneous

systems as taught by Alumbaugh (see 0066, 0099).

Claims 6 and 20 correspond respectively to a system and computer-accessible

medium for the method of claim 10, thus are rejected for the same reasons stated in

claim 13 discussed above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

8.   Claims 1-21 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1-5, 7-12, 14-20

of copending Application No. 10/723,704. Although the conflicting claims are not

identical, they are not patentably distinct from each other because claim 1 of copending

application for example merely differs from claim 1 of the instant application by

replacing "an operation to access content of a first file" by "an operation to modify an identity of a first file". In order to modify an identity of a file, clearly the file has to be accessed first. Claim 2 of the instant application recites "said operation corresponds to a file read operation or a file write operation" while claim 2 of the copending application recites "said operation corresponds to a file create operation, a file delete operation, a file rename operation, or a file copy operation". Note that in order to copy a file, a file read operation has to be also performed. Claim 3 of the instant application recites "said operation is generated by an application and wherein said record includes an identity of said application". Although the copending application does not specifically claim these features, since the operation generated by an application is recorded in a history stream, it would have been obvious to one of ordinary skill in the art to include an identity of said application in said record while implementing the method of the instant application in order to identify the application as the access request source in the history stream. Thus claims 1-21 of the instant application are either anticipated by or obvious over claims 1-5, 7-12, 14-20 of the copending application.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lambert et al (US 2002/0099952) teach policies for secure software execution.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Uyen T. Le whose telephone number is 571-272-4021.

The examiner can normally be reached on M-F 9:00-5:30.

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

11.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

10 May 2006

UYEN LE
PRIMARY EXAMINER